

Application No. 10/643,696  
Response to Office Action of March 30, 2005

REMARKS/ARGUMENTS

Claims 12 and 15 are cancelled. Claims 1 and 24 are amended. Support for the amendments to Claims 1 and 24 can be found at originally-filed Claims 12 and 15. Claims 29-30 are added. Support for the newly added claims is found throughout the specification, especially in the Examples at pages 8-11, and in the originally filed claims, especially Claims 1, 24, 12, and 15. New Claims 29 and 30 further contain subject matter of TAPPI 75-degree gloss that is not disclosed by WO'793 which are a sub-range of the broader range now present in Claims 1 and 24. Support for the boundaries of this sub-range is found in the examples and in the originally filed specification and claims. No new matter is believed to be introduced by the amendment.

Applicants thank Examiner Nakarani for the helpful comments within the outstanding Office Action explaining the reasons for the rejections.

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**Rejection(s)**

The rejection of Claim 1, 5-7, 9, 14, 19, 23-24, and 28 under 35 USC §102(b) over USP WO 01/55793 (WO'793) is believed to be obviated by the amendment above.

Applicants thank Examiner Nakarani for indicating that neither Claim 12, nor Claim 15, is disclosed or suggested by WO'793 alone because WO'793 fails to disclose the claimed Parker Print Smoothness and/or the claimed TAPPI 75-degree gloss (see page 3, lines 7-8 of the Office Action). Newly amended Claims 1 and 24 have been amended to include the subject matter of Claims 12 and 15. New Claims 29 and 30 further contain subject matter of TAPPI 75-degree gloss that is not disclosed by WO'793 which are a sub-range of the broader range now present in Claims 1 and 24.

In light of all of the above, none of the pending applications are disclosed or suggested by WO'793. Accordingly, withdrawal of this ground of rejection is respectfully requested.

The rejection of Claim 1, 5-7, 9, 14, 19, 23-24, and 28 under 35 USC §103(a) over WO 01/55793 (WO'793) in combination with USP 5,592,082 is traversed below.

WO'793, at best, discloses a coated matted paper. WO'793 fails to disclose a coated glossy paper, especially a paper substrate coated on at least one side with a pigmented coating containing a mixture of at least three different pigments and a binder where the coating

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provides a glossy coating surface having a TAPPI 75-degree gloss of from 45 to 85% and a Parker Print Surface of from 0.8 to 2.0.

At page 4, lines 5-8, WO'793 discloses that the coating described therein (which must contain gypsum as taught throughout this reference):

“... especially suited for the printing of a sheet of  
matt paper or board. . . .”

Further, at page 4, lines 5-8, WO'793 discloses that:

“If the target paper gloss is below 40-50%, the  
papers are called matt or satin papers.”

Accordingly, WO'793 discloses that the coating described therein is for matt papers having a 75-degree gloss of less than 40-50%.

In direct contrast to WO'793, the present invention relates to a glossy coated paper, specifically a paper substrate coated on at least one side with a pigmented coating containing a mixture of at least three different pigments and a binder where the coating provides a glossy coating surface having a TAPPI 75-degree gloss of from 45 to 85% and a Parker Print Surface of from 0.8 to 2.0. The coating of the present invention provides a coated paper surface having a TAPPI 75-degree gloss that is equal to or greater than 40-50%, i.e. from 45 to 85%.

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Since WO'793 discloses that the paper coating described therein is for providing a TAPPI 75-degree gloss suitable for matt paper and that matt paper has a TAPPI 75-degree gloss that is below 40-50%, WO'793 teaches away from a coated glossy paper having a TAPPI 75-degree gloss of from 45 to 85%. Accordingly, WO'793 teaches away from the claimed invention. Further, WO'793 provides no motivation to combine the coating described therein with a reference that wishes to produce a glossy paper having a TAPPI 75-degree gloss that is equal to or greater than 40-50%.

At best, US'082 discloses a paper that, when coated has a 75-degree gloss that is equal to or greater than 40-50%, i.e. about 45% (See lines 14-15 of the abstract and column 2, lines 29-30 of US'082). Further, US'082 discloses that the Parker Print Smoothness of the desired coated paper must be greater than 2.0, i.e. 2.1 to 2.3 (See column 7, lines 25-20). Still further, US'082 discloses at column 7, lines 20-25:

“A Parker Print Smoothness reading of 2.1-2.3 for the paper of the invention indicates that the paper is not particularly smooth compared to conventional coated gloss paper. A lack of extreme smoothness provides the paper with increased surface friction and improved runnability through a copier.”

Accordingly, US'082 teaches that the paper described therein must have a Parker Print Smoothness of greater than 2.0, i.e. 2.1 to 2.3, in order to provide enough friction for efficient copier runnability.

In direct contrast to US'082, the present invention is able to provide for a functional coated glossy paper having a Parker Print Surface of less than 2.0, or from 0.8 to 2.0. Since

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US'082 fails to disclose or suggest, and even teaches away from the claimed invention, it can not possible anticipate and/or be utilized alone as the basis of suggesting the invention.

The Office appears to critically rely on the comparative conventional examples provided in US'082 to demonstrate that paper may achieve the claimed Parker Print Smoothness. However, it should be noted that there is a critical lack of disclosure present in US'082 with regards to the comparative conventional examples provided therein. US'082 fails to disclose the components within the coatings utilized in the comparative examples of the conventional coated papers provided by US'082 altogether. US'082 only provides for the coating formulation for the exemplified invention at column 7, lines 26 to 41.

In light of the above, there is not one piece of evidence found in US'082 that conventional coated papers described therein are coated with a formulation as claimed in the present invention. The absence of such disclosure is fatal in that it does not provide for each and every element of the claimed invention. Accordingly, even if the claimed Parker Print Smoothness is achieved by the comparative examples of US'082, the Office can not sustain a prima facie case of obviousness on the basis thereof because US'082 fails to disclose that such examples have a coating containing each of the claimed components.

In order to make up for the deficiencies of the disclosure in WO'793, the Office combines the disclosure of WO'793 with US'082. However, US'082 discloses that it aims to produce a paper having a medium gloss and having a TAPPI 75-degree gloss that is equal to or greater than 40-50%, i.e. about 45% (See lines 14-15 of the abstract and column 2, lines

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29-30 of US'082). As discussed above, there is no motivation to combine the disclosure of WO'793 with the disclosure of US'082 because US'082 wishes to produce a glossy paper having a TAPPI 75-degree gloss that is equal to or greater than 40-50%, while WO'793 teaches that the coating described therein is suitable for matt papers or papers having a TAPPI 75-degree gloss that is below 40-50%.

In light of the above, the disclosures of WO'793 and US'082 provide no motivation therein to combine with each other, respectively. In fact, they teach away from combining the two disclosures because the coatings described therein provide for TAPPI 75-degree glossinesses that are completely in opposite to each other. Since not all of the limitations of the presently pending claims are disclosed, much less suggested, by either of WO'793 and/or US'082 standing alone (as indicated throughout the Office Action) and these references can not be combined as reasoned above, then neither of the WO'793 and US'082 alone anticipate and/or suggest the invention. Accordingly, withdrawal of this ground of rejection is respectfully requested.

In a case where the Office continues to find motivation to combine WO'793 and US'082, Applicants provide remarks below that the combination of these references would actually teach away from the claimed invention.

As discussed above, WO'793 teaches away from a coated paper having a TAPPI 75-degree gloss of from 45 to 85%. Further, as discussed above, US'082 clearly teaches away from a coated paper having a Parker Print Surface Smoothness of less than or equal to 2.0.

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Further, the components within the coatings utilized in the comparative examples of the conventional coated papers provided by US'082 throughout the examples therein are not disclosed (Only the components within the coating utilized in the inventive example is disclosed by US'082). Therefore, even if WO'793 were able to be combined with US'082, the combination of the two disclosures would, at best, suggest the production of a matt paper having a TAPPI 75-degree gloss of below 40-50% and a Parker Print Smoothness of greater than 2.0, i.e. 2.1 to 2.3.

In direct contrast to this suggestion, the present invention relates to a to a glossy coated paper, specifically a paper substrate coated on at least one side with a pigmented coating containing a mixture of at least three different pigments and a binder where the coating provides a glossy coating surface having a TAPPI 75-degree gloss of from 45 to 85% and a Parker Print Surface of from 0.8 to 2.0. In light of the above, if WO'793 were able to be combined with US'082, even the combination thereof would actually teach away from the claimed invention. Accordingly, the present invention is neither disclosed, nor suggested by any of WO'793, US'082, and/or any combination thereof.

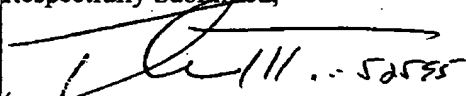
In light of all of the above, Applicants respectfully request withdrawal of these grounds for rejection.

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Applicants respectfully submit that the present application is now in condition for allowance. Favorable reconsideration is respectfully requested. Should anything further be required to place this application in condition for allowance, the Examiner is requested to contact below-signed by telephone.

Please charge the amount of \$450.00 required for the request for extension of time to our Deposit Account No. 09-0525. In the event any variance exists between the amount enclosed and the Patent Office charges for filing the above-noted documents, including any fees required under 37 C.F.R. 1.136 for any necessary Extension of Time to make the filing of the attached documents timely, please charge or credit the difference to our Deposit Account No. 09-0525. Further, if these papers are not considered timely filed, then a petition is hereby made under 37 C.F.R. 1.136 for the necessary extension of time.

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